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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,178	02/25/2004	Renee C. Nesnidal	015163-0310	4705
23524	7590	11/22/2005	EXAMINER ROSENBERGER, FREDERICK F	
FOLEY & LARDNER LLP 150 EAST GILMAN STREET P.O. BOX 1497 MADISON, WI 53701-1497			ART UNIT 2884	PAPER NUMBER

DATE MAILED: 11/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/786,178	NESNIDAL ET AL.	
	<b>Examiner</b> Frederick F. Rosenberger	<b>Art Unit</b> 2884	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 29 September 2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-37,40,42 and 43 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) 1-11,13-29,31-36,40,42 and 43 is/are allowed.  
 6) Claim(s) \_\_\_\_\_ is/are rejected.  
 7) Claim(s) 12, 30, 37 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 29 September 2005 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendments to the claims, filed on 9 September 2005, have been received and entered. Claims 4, 12, 14, 19, 20, 22, 23, 40, 42, and 43 have been amended. Claims 38, 39, and 41 have been cancelled. Accordingly, claims 1-37, 40, 42, and 43 are pending in this application.
  
2. Applicant's amendments to the claims have overcome the objections of claims 12, 16, 23, and 24, as detailed in paragraph 2 of the prior Office action. Similarly, the amendments have overcome the objections to claims 19 and 40, as detailed in paragraphs 3 and 4 of the prior Office action. Further, the cancellation of claim 38 has overcome the objection of claims 26 and 38, as detailed in paragraph 6 of the prior Office action.
  
3. Applicant's amendments to the drawings, filed on 29 September 2005, have been received and entered. These drawings are acceptable.

### ***Claim Objections***

4. Claim 12 is objected to because of the following informalities: In claims 12, lines 2-3, the multiple recitations of "incoming beam" should be --input beam-- so as to provide proper antecedent basis. In claim 12, line 3, "reflected return beam" should be -

-reflected beam-- so as to provide proper antecedent basis. Appropriate correction is required.

5. Claim 30 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 37. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Previously, claims 30 and 37 had been objected to as being a duplicate of claim 41. Although claim 41 has been cancelled, claims 30 and 37 are still substantially similar so as to be considered duplicates of one another.

#### ***Allowable Subject Matter***

6. Claims 1-11, 13-29, 31-36, 40, 42, and 43 are allowed. Claim 12 would be allowable if amended to correct the minor informalities, as discussed above. Claims 30 and 37 would be allowable if amended to overcome the duplicate claim objections, as discussed above.

7. The following is a statement of reasons for the indication of allowable subject matter:

Independent claims 1, 4, 7, 25, 28, 31, and 35 have the feature of using mirrors selectively interposed within a particular beam path in an IR microscope for re-

configuring the beam around the microscope aperture. While configurable beam paths using selectively interposable mirrors are known in the art of IR microscopy, the feature of employing interposable mirrors to circumvent or bypass the microscope aperture element en route to the output beam path is novel feature, regardless of if applied to the transmitted beam path or the reflected beam path. Placing interposable mirrors in the input beam path is also known in the art, but in those instances the mirror is either placed after the aperture (i.e. between the optics and the aperture not between the source and aperture) or is used to circumvent the microscope optics all together. Since the prior art neither teaches nor suggests such features, applicant's disclosure provides a novel and nonobvious improvement over the prior art. Accordingly, the present claims would be allowable.

### ***Conclusion***

8. This application is in condition for allowance except for the following formal matters:

- a. Objections to the claims (Paragraphs 4 and 5).

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick F. Rosenberger whose telephone number is 571-272-6107. The examiner can normally be reached on Monday-Friday 8:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Porta can be reached on 571-272-2444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Frederick F. Rosenberger  
Patent Examiner  
GAU 2884



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